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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,451	04/20/2001	David Cortis	4232-4002	4838
7590 MORGAN & FINNEGAN, L.L.P. 345 Park Avenue New York, NY 10154-0053			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 02/20/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/839,451

**Applicant(s)**

CORTS ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 213-228 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 213-228 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-640)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 221-228 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) At the last two lines of claim 221, "a digital information waveform encapsulated in a series of RF sub-carriers" is new matter.

(B) At line 2 in each independent claim 213 and 221, "identifying when broadcast data need to be transmitted" is new matter.

3. Claims 221-228 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. At line 2 in each independent claim 213 and 221, "identifying when broadcast data need to be transmitted" is not enabled. It is not disclosed how said "need" is determined.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 213-228 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 2 in each independent claim 213 and 221, "identifying when broadcast data need to be transmitted" is indefinite. It is not disclosed how said "need" is determined.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 213-220 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US006192340B1) in view of Schumacher, Jr., et al. (US005615227A).
8. Abecassis teaches (independent claim 213) a method comprising:

receiving from at least one of multiple broadcasters (*a plurality of providers 411-413*, providing service by *radio 404*, col. 11 lines 1-19 and Fig. 4) broadcast schedule information (*Providing a broadcast schedule*, col. 16 lines 40-46) identifying when broadcast data is to be transmitted over specific broadcast channels at predetermined times (a "broadcast schedule" inherently identifies "broadcast information to be transmitted over specific channels at predetermined times") from the at least one of multiple broadcasters to an end user (*a plurality of providers 411-413*, providing service by *radio 404*, col. 11 lines 1-19 and Fig. 4);

analyzing the received broadcast schedule information (applying the *schedule/scheduling, music and information preferences*, col. 17 lines 37-42 and col. 20 lines 23-52) and, based upon the analysis, identifying supplemental digital data (*information 755*, col. 20 lines 59-61 and Fig. 7) to be provided to a broadcaster from among the at least one of the multiple broadcasters, the supplemental digital data being correlated (*coordinated*, col. 21 lines 63-67) to broadcast data such that both can concurrently be provided by the broadcaster; and

providing the supplemental digital data to the broadcaster (*a radio-on-demand provider system 411*, col. 11 lines 1-6, 12-19 and 22-44) prior to the predetermined time for broadcast of the broadcast data as specified in the broadcast schedule information (col. 16 line 40-46) so that the broadcaster can concurrently broadcast both the broadcast data and the correlated supplemental digital data to the end user at the predetermined time.

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9. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

"identifying when broadcast data need to be transmitted".

A "need" is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

10. Abecassis does not teach concurrently broadcasting both the broadcast data and the correlated supplemental digital data at the predetermined time as part of an in-band, on-channel transmission (IBOC transmission). Schumacher, Jr., et al. teaches concurrently broadcasting both the broadcast data and the correlated supplemental digital data at the predetermined time as part of an IBOC transmission (col. 1 lines 23-25). Under *KSR v. Teleflex* (82 USPQ 2d 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Abecassis teaches every feature of the claims except IBOC transmission. Schumacher, Jr., et al. teaches IBOC transmission.
11. Abecassis also teaches at the citations given above claims 214-217 and 220. Abecassis also teaches claim 218 (at the end of the Abstract).
12. Abecassis also separately teaches (claim 219) multiple and multimedia presentations that can be simultaneously broadcast col. 5 lines 25-34 and 56-58). It is noted that the instant application also does not literally disclose "multiple multimedia" presentations that can be simultaneously broadcast.
13. Claims 221-228 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US006192340B1).
14. Abecassis teaches (independent claim 221) a method comprising:
- receiving from at least one of multiple broadcasters (*a plurality of providers 411-413*, providing service by *radio 404*, col. 11 lines 1-19 and Fig. 4) broadcast schedule information (*Providing a broadcast schedule*, col. 16 lines 40-46) identifying when broadcast data is to be transmitted over specific broadcast channels at predetermined times (a "broadcast schedule" inherently identifies "broadcast information to be transmitted over specific channels at predetermined times") from the at least one of multiple broadcasters to an end

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user (a plurality of providers **411-413**, providing service by radio **404**, col. 11 lines 1-19 and Fig. 4);

analyzing the received broadcast schedule information (applying the *schedule/scheduling, music and information preferences*, col. 17 lines 37-42 and col. 20 lines 23-52) and, based upon the analysis, identifying supplemental digital data (*information 755*, col. 20 lines 59-61 and Fig. 7) to be provided to a broadcaster from among the at least one of the multiple broadcasters, the supplemental digital data being correlated (*coordinated*, col. 21 lines 63-67) to broadcast data such that both can concurrently be provided by the broadcaster; and

providing the supplemental digital data to the broadcaster (a *radio-on-demand provider system 411*, col. 11 lines 1-6, 12-19 and 22-44) the predetermined time for broadcast of the broadcast data as specified in the broadcast schedule information (col. 16 line 40-46) so that the broadcaster can concurrently broadcast both the broadcast data and the correlated supplemental digital data to the end user at the predetermined time.

15. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

"identifying when broadcast data need to be transmitted".

A "need" is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

16. Abecassis does not teach concurrently broadcasting both the broadcast data and the correlated supplemental digital data at the predetermined time as part of a digital information waveform encapsulated in a series of RF sub-carriers. Because it would improve efficiency, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add concurrently broadcasting as part of a digital information waveform encapsulated in a series of RF sub-carriers to the teachings of Abecassis.
17. Abecassis also teaches at the citations given above claims 222-225 and 228. Abecassis also teaches claim 226 (at the end of the Abstract).
18. Abecassis also separately teaches (claim 227) multiple and multimedia presentations that can be simultaneously broadcast col. 5 lines 25-34 and 56-58). It is noted that the instant

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application also does not literally disclose "multiple multimedia" presentations that can be simultaneously broadcast.

### ***Response to Arguments***

19. Applicant's arguments filed with an amendment on 18 January 2009 have been fully considered but they are not persuasive. Applicant argues (pp. 6-8) that, "a digital information waveform encapsulated in a series of RF sub-carriers", is not new matter. (See the rejection under 35 USC 112, repeated as para. 2-3 above.) First, it is noted that applicant's four lines of argument in the middle of p. 6, beginning with "In-band on-channel" and ending three lines later with "frequency issues", is not clearly prior art: it is a near-verbatim copy of material found in a Wikipedia article by the examiner on 14 February 2009. See the highlighted seven lines in the Wikipedia article "In-band on-channel" made of record herein.
20. In any event, the arguments are not compelling. Applicant is correct that support need not be verbatim, but the applicant has failed to show support for the substance of the new language. For example, the new language is claiming a waveform in a series of sub-carriers. A "waveform" is a wave shape over time (NYTimes reference dictionary). Applicant is claiming that some one wave shape appears in a series of sub-carriers. There is no support for this in the specification as filed.
21. Support for the new amendment: Applicant states (p. 8 bottom) that support for "identifying when broadcast data need to be transmitted" is in para. [0009] and [0010] of the published application. No such support was found for this "need" in either of the cited paragraphs or elsewhere in the specification as filed.
22. Applicant argues, "The radio-on-demand provider system of Abecassis is (A) NOT configured to provide any schedule information to anyone and is (B) NOT configured to receive any schedule information from broadcasters." (Emphasis added.) That is not correct. As to applicant's point "A", there is no claim limitation to "provide ... schedule information". However, Abecassis does teach teaches "Providing a broadcast schedule" (col. 16, line 40), which reads on the claimed "broadcast schedule information".
23. As to applicant's point "B", Abecassis teaches providing a schedule/broadcast schedule information to a *Multimedia Player* (col. 16 lines 31-40), which literally reads on said a

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*Multimedia Player* receiving said schedule/broadcast schedule information. *Multimedia Player* is the reference term for both a transmitter and receiver, for the reference, in one embodiment, teaches,

*"Participants in the network 400, however, whether classified as providers 411-413 or end user 431-438 are both providers and end users of audio, video, and information services. Analogous to a communications network, each participant is able to retrieve and transmit audio and information from any other participant".* (Abecassis, col. 11 lines 3-8, emphasis added)

The schedule/broadcast schedule information is being provided to enable satisfying a user's preferences (col. 16 lines 40-43). This is a function of a *provider*/broadcaster, so the broadcast schedule/broadcast schedule information is being provided to a *provider ... of audio, video, and information services* (col. 11 lines 3-6). From whom is said broadcast schedule/broadcast schedule information being received? Necessarily, either directly or indirectly, from another *provider*/broadcaster, because said other *provider*/broadcaster created the schedule. Hence, as noted in para. 8 of the rejection, Abecassis does teach "receiving from at least one of multiple broadcasters broadcast schedule information".

### **Conclusion**

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The

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examiner can normally be reached Monday, Wednesday morning, and after Noon on Thursday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

26. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
28. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
29. Applicant may have after final arguments considered and amendments entered by filing an RCE.
30. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
31. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their

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registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov).

At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

14 February 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688